

### REMARKS/ARGUMENTS

The final office action of December 4, 2003 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 35-53 remain in this application. Claims 1-34 were previously canceled.

Claims 35-53 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Spyglass Prism, *Concepts and Applications* (pages 1-8) and Spyglass Prism 1.0 (pages 1 and 2), 3/1997 (hereinafter Spyglass) in view of *Elements of Editorial Style For Computer-Delivered Information*, IEEE, March 1990 to Carliner. Applicants respectfully traverse this rejection.

Applicants continue to submit that the action has failed to establish that either of the Spyglass articles relied on in the rejection are prior art to the instant application. Nonetheless, in order to expedite prosecution, applicants have argued below against the rejection of the claimed invention applying Spyglass. In no way however, should applicants' arguments be construed as an acquiescence that Spyglass constitutes prior art to the present invention.

The action alleges that Spyglass discloses all the elements of independent claim 35, but for selecting one of a plurality of style sheets based upon the set of capabilities of the output device. To overcome this deficiency, the action relies on Carliner.

Spyglass describes a proxy server application that automatically adapts Internet content originally formatted for a PC to a format that matches the capabilities of a device (e.g., TVs, phones, PDAs and pagers) requesting the content. The application (Spyglass Prism) performs the following functions:

1. Upon requesting a URL, a non-PC device connects to an Internet access provider's server where Spyglass Prism resides.
2. Once connected, the device identifies itself and the user to Spyglass Prism. This information is cross referenced against two different databases. The first is the User Database, used to track information such as the user preferences. The second database is the Device Database. This database contains the characteristics of various devices, such as display, resolution, color or monochrome support, and text or graphics display.
3. Using its own fully functional Web browser component, Spyglass Prism accesses the URL requested by the user.

4. After retrieving the data, Spyglass Prism uses its stored data about the Web site, the user and the device to convert the data into the best format for the device.

Spyglass Prism, *Concepts and Applications*, p. 2.

Carliner describes why a different editorial style needs to be used to format computer-delivered information on a computer display than for a printed page. To account for the stylistic differences between a computer display and a printed page, Carliner provides an approach for developing a style sheet for information delivered on a computer display.

The action has acknowledged that Carliner does not teach or suggest selecting one of a plurality of style sheets based upon the set of capabilities of the output device. Before discussing the combination of Carliner with Spyglass, the action contends that it would have been obvious to modify Carliner to include selecting one of a plurality of style sheets based upon the set of capabilities of the output device. According to the action at p. 4, one would have modified Carliner because “[w]riting computer-delivered information using the style sheets for formatting the information where the information is rendered differently on different output devices suggests that an appropriate style sheet be selected to match the characteristics of the output device.”

After having modified Carliner, the action then alleges that it would have been obvious to combine Spyglass and Carliner since Carliner provides the style sheets for delivering computer information to a computer display or printer and Spyglass determines the capabilities of an output device connected to a computer. The combination of Spyglass and Carliner according to the action at p. 4 would have resulted in “a method for formatting a document according to the style sheet that can be changed to match the characteristics of the output device.” Applicants submit that the combination as proposed is not proper as the action has modified Carliner prior to combining it with Spyglass and makes the inaccurate representation that Carliner provides the style sheets for delivering computer information to a computer display or printer. Only by modifying Carliner was the action able to assert that Carliner included such a feature.

Even assuming, but not admitting, that the proposed combination would have resulted in the invention of claim 35, applicants submit that one skilled in the art would not have had incentive or been motivated to modify Spyglass to include selecting one of a plurality of style

sheets based upon the set of capabilities of the output device as allegedly found in Carliner. Tellingly, Spyglass has no need for selecting style sheets based upon the set of capabilities of the output device. Nor has the action identified any motivation or incentive as to why one would have modified Spyglass to include such a feature. Notably, with Spyglass Prism a non-PC device identifies itself and the user to Spyglass Prism. This information is cross referenced against the User Database and the Device Database. Subsequently, Spyglass Prism uses its stored data about the Web site, the user and the non-PC device to convert the data into the best format for the non-PC device.

The action further contends that it would have been obvious to have combined Spyglass with Carliner since Carliner provides the style sheets for delivering computer information to a computer display or printer and Spyglass determines the capabilities of an output device connected to a computer. This contention however is nothing more than an exercise of impermissible hindsight. The action has taken applicants' claim 35 and hunted through the prior art in an attempt to construct the invention. No motivation or incentive for combining Spyglass and Carliner at the time of the invention has been provided.

In light of the foregoing, claim 35 is patentably distinct from the applied combination. Furthermore, claims 36-42, which ultimately depend from claim 35, are allowable over the art of record for the same reasons as set forth with respect to claim 35, and further in view of the advantageous features recited therein.

Independent 43 calls for, among other features, generating a selected style sheet based upon the set of capabilities of the output device using the layout generator. The action applied the combination Spyglass and Carliner to reject claim 43 for substantially the same reasons as independent claim 35. Not surprisingly, claim 43 is patentably distinct from the combination of Spyglass and Carliner for at least substantially the same reasons set forth with respect to claim 35. Also, claims 44-47 are considered allowable for the same reasons as claim 43, and further in view of the advantageous features recited therein.

Independent claim 48 calls for, among other features, based upon the set of capabilities of the output device, generating a style sheet having a plurality of style definitions for formatting the document for presentation on the output device. The action applied the combination Spyglass

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and Carliner to reject claim 48 for substantially the same reasons as independent claim 35. Not surprisingly, claim 48 is patentably distinct from the combination of Spyglass and Carliner for at least substantially the same reasons set forth with respect to claim 35. Also, claims 49-53 are considered allowable for the same reasons as claim 48, and further in view of the advantageous features recited therein.

### CONCLUSION

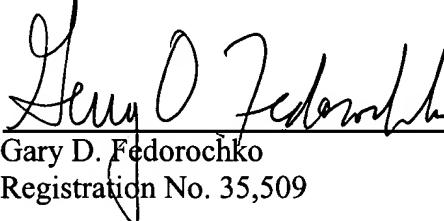
It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

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